

Appl. No. 09/265,073
Preliminary Amendment

REMARKS

Applicants hereby add claim 67. Claims 1-25, 27-42, and 51-67 are pending in the present application.

Claims 1-3, 6-8, 11-13, 16-18, 21, 22, 24, 25, 27-29, 33-37, 41-42, 51-53, 55-57, 64 and 65 stand rejected under 35 U.S.C. §103(a) for obviousness over U.S. Patent No. 5,842,118 to Wood, Jr. in view of U.S. Patent No. 5,649,296 to MacLellan et al. and U.S. Patent No. 6,058,374 to Guthrie et al. Claims 4-5, 14-15, 23, 30-32, 38-40 and 54 stand rejected under 35 U.S.C. §103(a) for obviousness over Wood, Jr. in view of MacLellan and Guthrie in further view of U.S. Patent No. 5,799,010 to Lomp et al. Claims 9, 10, 19 and 20 stand rejected under 35 U.S.C. §103(a) for obviousness over Wood, Jr. in view of MacLellan and Guthrie in further view of U.S. Patent No. 6,353,729 to Bassirat. Claims 58-63 and 66 stand rejected under 35 U.S.C. §103(a) for obviousness over Wood, Jr. in view of MacLellan and Guthrie and U.S. Patent No. 6,084,530 to Pidwerbetsky et al.

Referring to the 103 rejections, to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The prima facie case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990). As discussed in *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984), the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability including some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l v.*

Appl. No. 09/265,073
Preliminary Amendment

Teleflex, Inc., 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007).

Referring to claim 1, Applicants respectfully assert that the Office Action fails to present a prima facie 103 rejection under KSR for the below-mentioned compelling reasons. More specifically, the rationale for combining the references presented by the Office is not supported by a rational underpinning, and in particular, the rationale for combining MacLellan with Wood is insufficient and the rationale for combining Guthrie with the combination of MacLellan and Wood is inconsistent and contradictory to the rationale for combining MacLellan and Wood.

Referring to the combination of MacLellan and Wood, the Office states on page 10 that Wood suggests power adjustment to communicate with a remote device. The teachings of col. 6, lines 30+ of Wood teach advantages of RF systems compared with magnetic systems including increased range. These teachings provide that the power of the interrogator is adjustable so that only devices within a certain range will respond. Accordingly, these teachings are directed towards selectively decreasing the communications range of the interrogator to a desired communications range. Applicants respectfully submit that these teachings to *selectively reduce the range of communications* provides no rational underpinning for combining the LAN of MacLellan which is cited by the Office to *increase the communications range*. Indeed, Wood directly teaches selectively decreasing the range of communications so that only certain devices will respond and the rationale provided by the Office to look to MacLellan for teachings to increase range is directly contradictory to the explicit teachings of Wood for selectively decreasing range so only certain devices respond. MPEP 2143.01 V (8th ed., rev. 6) provides that there is insufficient basis to make a proposed modification for a proper 103 rejection if the

Appl. No. 09/265,073
Preliminary Amendment

proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Applicants respectfully submit there is insufficient motivation to combine the teachings of MacLellan with Wood for the above-mentioned compelling reasons.

In addition, the motivation for combining the teachings of Gunthrie with Wood and MacLellan is contradictory to the motivation for combining MacLellan with Wood.

Referring to page 10 of the Action, the Office states that *MacLellan teaches an interrogator 103 remotely connected via LAN 102 to extend the range of communication*. The Office further states at page 10 of the Action that the combination of MacLellan and Wood is proper to extend the range of communication. At page 12 of the Action, the Office alleges that it is obvious to modify the combination of Wood and MacLellan according to the teachings of Guthrie *to extend the range of communication without a local area network (LAN)*. Applicants respectfully submit that the above-mentioned arguments of the Office fail to provide an articulated reason with a rational underpinning to support a proper 103 rejection.

To the contrary of meeting the requirements of KSR, the alleged underpinning provided by the Office in support of the combination of two of the three references (Wood and MacLellan) is contradictory and inconsistent with the underpinning for combining the third of the references (Guthrie). In particular, Applicants respectfully submit it is improper to modify the combination of Wood and MacLellan with the arrangement of Guthrie when the rationale to combine the teachings of Guthrie are to extend communications range *without use of a LAN* making the system flexible and easy to implement (per page 12 of the Action) which is directly contrary and inconsistent from the rationale provided by the Office

Appl. No. 09/265,073
Preliminary Amendment

for the combination of Wood and MacLellan to *use the LAN* of MacLellan to extend the range of communication per page 10 of the Action.

The rationale for combining Guthrie to make the system flexible and easy to implement is based upon not including a LAN. However, as set forth above, the Office relies upon the use of the LAN of MacLellan to support the combination of Wood and MacLellan to extend the range of communications of Wood. It is inconsistent and not rational to allege a motivational rationale to combine the teachings of Guthrie with Wood and MacLellan when the rationale for combining Guthrie is directly contradictory to the rationale for combining Wood and MacLellan (the combined teachings being further modified by Guthrie).

If the rationale to combine the teachings of Guthrie with the combination of Wood and MacLellan (to extend range of communication without use of a LAN to make the system flexible and easy to implement) is deemed proper to combine the teachings of Guthrie, then Applicants respectfully submit there is no proper support for combining the teachings of MacLellan with Wood which the Office alleges is the use of the LAN of MacLellan to extend the range of communications of Wood.

In addition, Applicants submit that the teachings of the combination of Wood and MacLellan which use the LAN to extend the communications range (and the extension of the communications range is the motivation for combining MacLellan with Wood) teaches away from the combination proposed by the Office to extend range according to Guthrie without a LAN. Applicants respectfully submit that either the motivation for the combination of Wood and MacLellan or the motivation for the combination of Guthrie with Wood and MacLellan is erroneous in consideration of the disparate and different rationales provided

Appl. No. 09/265,073
Preliminary Amendment

by the Office for combining the three references: using a LAN to extend range to combine MacLellan with Wood versus extending range without use of a LAN to make the system "flexible and easy to implement" to combine Guthrie with Wood and MacLellan. *The combination of Wood and MacLellan teaches away from constructions void of LANs when the combination of Wood and MacLellan has been expressly indicated to be appropriate because of the use of the LAN of MacLellan to extend range.*

Applicants respectfully submit that there is an inadequate rational underpinning to combine the Guthrie teachings when the teachings of Wood and MacLellan when the combined teachings of Wood and MacLellan already disclose the benefits for which Guthrie is presented. In particular, the Office states that it is proper to combine the teachings of MacLellan with the teachings of Wood to extend the range of communications. Accordingly, the *combination of Wood and MacLellan* (without modification per Guthrie) already provides extended range as noted by the Office and the rationale of combining the teachings of Guthrie to extend range are redundant to the already combined arrangement of Wood and MacLellan which has an extended range of communications. Applicants respectfully submit that the alleged rationale for combining Guthrie is improper and fails to establish a proper prima facie 103 rejection.

With reference to the "Response to Arguments" section of page 2 of the Office Action with respect to claim 1, the Office merely repeats almost verbatim the language set forth in pages 9-12 of the Office Action in support of the rejection and which corresponds to the original rejection set forth in the Office Action of February 20, 2007. Applicants respectfully submit that page 2 of the Action fails to provide a proper articulated reason with a rational underpinning for combining the references for the above-mentioned

Appl. No. 09/265,073
Preliminary Amendment

numerous and compelling reasons.

Applicants respectfully submit that the Office has failed to establish a proper prima facie 103 rejection of claim 1 for at least the above-mentioned numerous and compelling reasons.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 3, Applicants respectfully submit that the teachings of MacLellan, Wood and Guthrie fail to teach the positively claimed limitations and the Office has failed to present a proper 103 rejection for at least this reason. In the last response, Applicants presented arguments as to how the teachings of MacLellan were misinterpreted in the Office Action dated February 20, 2007 in support of the 103 rejection. *The "Response to Arguments" section of the present Action merely repeats the arguments of the Office set forth in the February 20, 2007 Action and fails to address or respond to any of Applicants arguments set forth in the last response.* Applicants submit that claim 3 is allowable for the below-mentioned compelling reasons.

The Examiner at page 13 of the Action (and as repeated at page 5 of the "Response to Arguments" section of the Action) relies upon the teachings of Fig. 8 and col. 7, lines 26-47 of MacLellan as allegedly disclosing the claimed adjustment circuitry. A careful read of MacLellan including col. 7, lines 25-47 illustrate that a prior art device uses the full AM modulation scheme 601 of Fig. 8 while the inventive aspects of MacLellan (an entirely different communications system) utilize the partial AM modulation scheme 602 to implement full duplex communications. A CW tone is absent from the prior art scheme 601

Appl. No. 09/265,073
Preliminary Amendment

half of the time as shown in Fig. 8 while a CW tone is present at all times either at 50% or 100% power permitting full duplex with the carrier being always present. Usage of 100% or 50% modulation depends upon whether the system is a prior art system or the system of MacLellan. These teachings of MacLellan baldly refer to different modulation schemes and fail to disclose or suggest the limitations of the claims including the adjustment circuitry.

More specifically, the Office appears to recite at page 12 of the Action with respect to claim 3 the 100% AM or 50% AM (reference 601 of Fig. 8) or 100% AM and 50% AM (reference 602 of Fig. 8) as allegedly disclosing the claimed adjustment. However, the Office has failed to identify specific reference teachings which allegedly disclose the different limitations of the claims. For example, the Office has failed to identify any reference in such teachings of MacLellan regarding the different AM modulation schemes or provide any explanation as to how the different AM modulation schemes are to be considered to disclose or suggest the claimed adjustment circuitry of the communication station in combination with the other limitations. The Office has failed to identify teachings of the claimed adjustment circuitry of the communication station receiving the forward link communication signal or the adjustment of the electrical characteristic of the forward link communication signal. Baldy referring to a plurality of different AM modulation schemes of MacLellan of the prior art and the invention of MacLellan may not be fairly considered to disclose or suggest the specific limitations of the claims and Applicants respectfully submit the rejection of the claims is in error for at least this reason.

Referring to dependent claim 51, the system comprises circuitry of the housing comprising a transmitter configured to generate a modulated signal, and the communication station is configured to receive and convert the modulated signal from a

Appl. No. 09/265,073
Preliminary Amendment

first communication medium type to a second communication medium type. The above-recited positively-recited limitations of the claims are not disclosed nor suggested by the prior art and claim 51 is allowable for at least this reason.

On page 10 of the Action, the Office states that interrogator 103 of MacLellan teaches the claimed communication station (interrogator 103 is remotely located from application processor 101 of Fig. 1). However, MacLellan is void of disclosing that the interrogators 103 or 104 (identified as teaching the communication station) receive a modulated signal. To the contrary, MacLellan only discloses a modulator 202 within interrogator 103 itself.

Referring to page 13 of the Action and in support of the rejection of claim 51, the Office baldly alleges that MacLellan teaches a modulated digital signal out of computer 101 and that the signal within circuits 101-103 is a modulated signal. The generic teachings of Figs. 1-3 of MacLellan cited by the Office on page 13 of the Action fail to support the allegation that circuits 101-103 of MacLellan include a modulated signal or that the digital signal out of reference 101 is a modulated signal. Apart from generically identifying Figs. 1-3, the Office had failed to identify any teachings that a signal out of processor 101 is a modulated signal. Applicants have failed to uncover any teachings in Figs. 1-3 that the signal out of processor 101 is a modulated signal and the Office has failed to identify where in Figs. 1-3 that processor 101 outputs a modulated signal.

Referring to page 6 of the Action, the Office merely reiterates various teachings of processor 101, LAN 102 and interrogators 103-104 including a modulator of the interrogators 103, 104 modulating a signal. However, *the modulating within the interrogators (relied upon by the Office as teaching the claimed communication station)*

Appl. No. 09/265,073
Preliminary Amendment

fails to teach or suggest the claimed limitations of the circuitry of the housing comprising a transmitter configured to generate a modulated signal or the claimed communication station receiving a modulated signal.

Applicants also submit that the conclusion on page 6 of the Action that the signal transmitted from processor 101 is modulated and the LAN 102 transmits modulated signals is erroneous and not supported by any prior art teachings. Applicants also respectfully submit that the continued failure of the Office to identify teachings of the prior art which teach processor 101 outputting modulated signals is contrary to the holding of the Board in this application. In particular, Applicants respectfully refer the Office to the decision of the Board mailed November 16, 2006 at pages 19-20 where the Board discussed the failure of the Examiner to show that the host computer modulates signals it sends to the interrogator and the Board rejected the Examiner's reliance upon inherency that the signals out from processor 101 are modulated. The Office has failed to identify any prior art teachings of the processor 101 outputting a modulated signal or LAN 102 communicating a modulated signal.

Furthermore, Guthrie fails to cure the deficiencies of Wood and MacLellan with respect to the limitations of claim 51. Claim 51 recites *circuitry of the housing comprising a transmitter configured to generate a modulated signal, and the communication station is configured to receive and convert the modulated signal from a first communication medium type to a second communication medium type.* The transceiver of Fig. 3 of Guthrie fails to teach the claimed limitations inasmuch as the same type of communications (i.e., wireless communications) are communicated between references 3, 4, 5 which fails to teach or suggest *the communication station is configured to receive the*

Appl. No. 09/265,073
Preliminary Amendment

modulated signal and to convert the modulated signal from a first communication medium type to a second communication medium type as specifically claimed.

Applicants respectfully submit that the Office has failed to establish a proper prima facie 103 rejection inasmuch as limitations of claim 51 are not disclosed nor suggested by the prior art. Furthermore, Applicants respectfully submit that the continued rejection of claim 51 without the prior art teachings is contrary to the holding of the Board in the decision mailed November 16, 2006.

Referring to dependent claim 53, the generic teachings of Figs. 1-3 of MacLellan fail to teach or suggest the recited limitations of the *communication circuitry comprising a wired medium configured to communicate the forward link communication signal comprising the modulated signal intermediate the housing and the communication station*. Applicants also respectfully submit that the continued reliance upon MacLellan without identification of support of processor 101 outputting a modulated signal is contrary to the decision of the Board mailed November 16, 2006. Positively-recited limitations of claim 53 are not disclosed nor suggested by the prior art and claim 53 is allowable for at least this reason.

Referring to independent claims 11, 21, 27, and 35, Applicants respectfully submit there is insufficient motivation to combine the teachings of Guthrie with the combined teachings of Wood and MacLellan and the 103 rejection is improper for at least this reason.

The claims which depend from independent claims 11, 21, 27, and 35 are in condition for allowance for the reasons discussed above with respect to the independent claims as well as for their own respective features which are neither shown nor suggested by the cited art.

Appl. No. 09/265,073
Preliminary Amendment

Referring to independent claim 58, the Office alleges at page 24 of the Action that the combination of U.S. Patent No. 6,084,530 to Pidwerbetsky is proper because Wood suggests generating a forward link communication signal and Pidwerbetsky teaches generating a polling signal using circuitry of a source for purpose of reducing collision of responding communications. Applicants respectfully submit the Office has failed to provide an adequate articulated reason *with a rational underpinning* for combining the numerous references in support of the 103 rejection and the Office has failed to establish a proper prima facie rejection.

In particular, the Office has cited no authority or evidence in support of allegations of motivation to combine the reference teachings. Referring to pages 23-24 of the Action, there is no teachings in the prior art cited *in support of the position that* Pidwerbetsky generates a polling signal to reduce collisions of responding communications as baldly alleged. In fact, Applicants have electronically searched and failed to uncover any reference to "collision" or "reduction of collisions" in Pidwerbetsky as baldly alleged by the Office. The motivational rationale cited by the Office is not supported by a rational underpinning and the rejection is improper for at least this reason.

In addition, the Office points to no evidence that the system of Wood, MacLellan or Guthrie suffers from collisions of responding communications for which the teachings of Pidwerbetsky may be applicable. Further, Applicants have failed to uncover any teachings in Pidwerbetsky relevant to reducing collisions which is set forth as the rationale for combining the references in the first instance. Applicants respectfully submit there is insufficient proper rationale for combining the prior art teachings and the 103 rejection is improper for at least this reason.

Appl. No. 09/265,073
Preliminary Amendment

With reference to the "Response to Arguments" section of page 7 of the Office Action with respect to claim 58, the Office merely repeats almost verbatim the language set forth in page 24 of the Office Action in support of the rejection and which corresponds to the original rejection set forth in the Office Action of February 20, 2007. Applicants respectfully submit that page 7 of the Action fails to provide a proper articulated reason with a rational underpinning for combining the references for the above-mentioned numerous and compelling reasons.

The claims which depend from independent claim 58 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to dependent claim 60, claim 60 depends from claims 58 and 59 and recites the *communications media comprises a wire and electromagnetic energy for communicating respective ones of the polling signals of the first and second communication medium types*. In combination with the teachings of base claim 58, the polling signals of the first and second communication medium types are defined as modulated signals. Even if the prior art teachings are combined, the combination fails to disclose or suggest communication of a *modulated polling signal using communication medium types including a wire and electromagnetic energy*.

The Office alleges on page 24 of the Action that "all subject matters in claim 60 are disclosed in claim 8, and therefore rejection of the subject matters expressed in claim 60 are met by references and associated arguments applied to rejection of claim 8." Applicants respectfully submit the rejection of claim 60 set forth by the Office is not a proper prima facie rejection.

Appl. No. 08/265,073
Preliminary Amendment

In particular, claim 60 recites limitations including a wire and electromagnetic energy which are not "disclosed in claim 8" as alleged by the Office. The Office has failed to recite *prior art teachings* which allegedly disclose teachings of claim 60 in support of the rejection of claim 60. The limitations of claim 60 are not disclosed by the prior art when properly considered with the limitations of claims 58 and 59. Applicants respectfully submit that positively recited limitations of claim 60 are not disclosed by the prior art and the Office has failed to establish a proper prima facie 103 rejection for at least this reason.


Applicants have added new claim 67 which is supported at least by the teachings of Figs. 1 and 5-8 and the associated teachings of the specification.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 10/31/07

By: 
James D. Shaurette
Reg. No. 39,833